

CASE CT-2530-NP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF GRIBKOFF, ET AL.

EXAMINER: Laura

Stockton

APPLICATION NO: 09/975,881

ART UNIT: 1626

FILED: October 12, 2001

FOR: Selective Maxi-K Potassium Channel Openers Functional Under Conditions of High Intracellular Calcium Concentration, Methods and Uses Thereof

Assistant Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

A shortened statutory period for response to the outstanding Office Action mailed March 20, 2002, was due April 19, 2002. Submitted herewith is a request for an extension of time of two (2) months in which to reply. Accordingly, the extended due date for reply is June 19, 2002.

REMARKS

Claims 1 to 65 are pending in the application and are subject to a restriction requirement under 35 U.S.C. §121. The Examiner has required restriction to one of the following inventions:

- Group I: Claims 1-13 and 22-34, drawn to a method, classified in class 514.
Group II: Claims 14-21 and 35-45, drawn to a method, classified in class 514.
Group III: Claims 46-54, drawn to a method of screening, classified in class 435.
Group IV: Claims 55-59, drawn to a method of assaying, classified in class 435.
Group V: Claims 60 and 61, drawn to a product.
Group VI: Claims 62-65, drawn to products, classified in class 548, subclass 484+.

→ Applicants hereby provisionally elect with traverse the invention of Group I, claims 1-13 and 22-34, drawn to a method classified in class 514. In accordance with the provisional election, Applicants withdrawn from consideration claims 14-21 and 35-65 which are directed to non-elected inventions and is subject to Applicants' right to file a divisional application with respect thereto.

Secondly, the Examiner also required that Applicants elect a single disclosed species and that the election should be made by Example number and page number. In accordance with the Examiner's request and with the above provisional election of Group I, Applicants select Example 2 on page 27 of the specification.

In the present restriction requirement, the Examiner required that pending claims 1-65 be divided into six (6) separate and distinct inventions as identified above in Groups I to VI. For the purpose of this examination, the restriction requirement set forth by the Examiner for the invention of Group I is respectfully traversed. The main reason given by the Examiner for this restriction requirement is that the inventions are related as product and process and, therefore could be distinct inventions from one another. The Examiner also added that search considerations for each Group of inventions would impose an undue burden on the Examiner and the Patent Office resources.

Applicants do not disagree with the Examiner's request for restriction but only disagree with the number of Groups and the selection of claims within the Group of inventions. Instead, Applicants believe that the claims of Group I and Group II should be combined as one new Group such as Group Ia, claims 1-45, for the present

examination. The Examiner's argument for inventions which may be related as product and process could be applied to the inventions of Group I and Group VI, but the Examiner's argument does not apply to the inventions of Group I and Group II. It is respectfully submitted that the newly proposed Group Ia, claims 1-45, should not present any undue burden on the Examiner or the Patent Office for three reasons:

1. Both Group I and II are drawn to method;
2. Both Group I and II are classified in class 514; and
3. Claim 14 and dependent claims included within Group II could be classified as a subgenus of claim 1 within Group I, for example, treatment of stroke is a subgenus of a disease or a disorder. For discussion purposes, claim 14 could be considered a disclosed species or elected single subgenus.

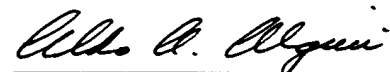
Applicants believe the Examiner has not made a case for the restriction of claims identified by Group I and Group II. Applicants respectfully request that the Examiner reconsider this part of the restriction requirement and examine the claims of Group I and Group II together as one new Group Ia.

Reconsideration of the restriction for examination of the provisional election is respectfully requested.

Respectfully submitted,

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Date: June 18, 2002



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